

REMARKS

The Final Office Action dated June 13, 2008 contained a final rejection of claims 1-15. Claims 1, 7, 10 and 11 have been amended. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114.

Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-15 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Applicants have amended the claims as suggested by the Examiner to overcome this rejection.

The Office Action rejected claims 1-3 and 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell (U.S. Patent Publication No. 2002/147795) in view of Minolta (JP2001117835 A, Derwent Abstract, PAJ Translation also provided), further in view of Williams et al. (U. S. Patent Publication No. 2002/0147795) and further in view of Hui (U.S. Patent Publication No. 2003/0220983). The Office Action rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell, Minolta, Williams, and Hui as applied to claim 1 and further in view of Anderson et al. (U.S. Patent No. 7,222,357). The Office Action rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell, Minolta, Williams, and Hui as applied to claim 1 and further in view of Koss (U.S. Patent Publication No. 2002/0112037). The Office Action rejected claims 7-13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell in view of Minolta in view of Williams, in view of Hui, and further in view of Shaefer (U.S. Patent Publication No. 2001/0053977). The Office Action rejected claim 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell, Minolta, Williams, Hui, and Shaefer as applied to claim 7 and further in view of Anderson et al. The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cantwell, Minolta, Williams, Hui and Shaefer as applied to claim 7 and further in view of Koss.

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

Namely, the Applicants newly amended independent claims now include communicating information regarding the type of personal computer and its operating system to the Internet location using header information provided by the web browser and automatically connecting the personal computer to the Internet location holding the device drivers using the URL and an embedded web server in the peripheral device configured to serve web pages for accessing the URL without user interaction immediately after the peripheral device is connected to the personal computer.

In contrast, although Cantrell disclose in paragraph [0015] that "...the device is capable of supporting its own website," this is in the context of when the "...user may browse 20 to the driver website in any of several ways..." including having the user "...browse to the actual device if the device is capable of supporting its own website." In other words, as disclosed by Cantrell, the "...device website contains a link to the driver website. The link includes necessary parameters such as address, port number, and model name attached to the end of the URL for the driver website. When the user follows the link to the driver website these parameters are passed to the driver website." As such, unlike the Cantrell, which has the user follow the link to the driver website, the Applicants' features of the independent claims use an embedded web server in the peripheral device to access the URL with the drivers automatically and **without user interaction**.

Therefore, since the combined references are missing at least one feature of the Applicants' claimed invention, the combined references cannot render the Applicants' invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicants' claimed invention indicates a lack of a prima facie case of obviousness and, thus, the obviousness rejection should be withdrawn (MPEP 2143).

Further, even though the combination of **five to six** cited references does not produce all of the elements of the claimed invention, these references should not even be considered together since there is no motivation to combine the cited references. First, there must be a basis in the references for combining or modifying the references and hindsight cannot be used to form this basis. For example, the Examiner cannot use a "tack-on" approach to arbitrarily "pick and choose" elements from numerous references and combine these elements with the benefit of hindsight.

Evidence that the Examiner used hindsight is clearly confirmed by the fact that the Examiner combined **five** (5) references in a piecemeal “tack-on” fashion without providing any reasoning for combining these references when rejecting claims 4-13 and **six** (6) references when rejecting claims 14-15. Contrary to the Examiner’s approach, the Applicants submit that there must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination, and that knowledge **cannot** come from the Applicants’ invention itself. In particular, the combination of elements in a manner that reconstructs the Applicant’s invention only with the benefit of hindsight is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar “...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously,” especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant’s claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant’s invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.

Therefore, because the combined references are missing features of the Applicant’s claimed invention and because the Examiner used improper hindsight, the combined references cannot render the Applicant’s invention obvious. This failure of the cited reference to disclose, suggest or provide motivation for the Applicant’s claimed invention clearly indicates a lack of a prima facie case of obviousness and, thus, the obviousness rejection should be withdrawn (MPEP 2143).

With regard to the rejection of the dependent claims, because they depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly requests the Examiner to telephone the Applicant's attorney at (818) 885-1575. Please note that all mail correspondence should continue to be directed to

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Respectfully submitted,
Dated: September 15, 2008

A handwritten signature in black ink, appearing to read 'Edmond A. DeFrank', is written over a horizontal line. To the right of the signature, there is a vertical dotted line.

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